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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,436	07/26/2001	Dwip N. Banerjee	AUS920010527US1	7371

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/915,436	BANERJEE ET AL.	
	Examiner	Art Unit	
	James A. Kramer	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Appeal Brief filed on 1/10/06, PROSECUTION IS HEREBY REOPENED. Reason for reopening as well as a new grounds of rejection are set forth below.

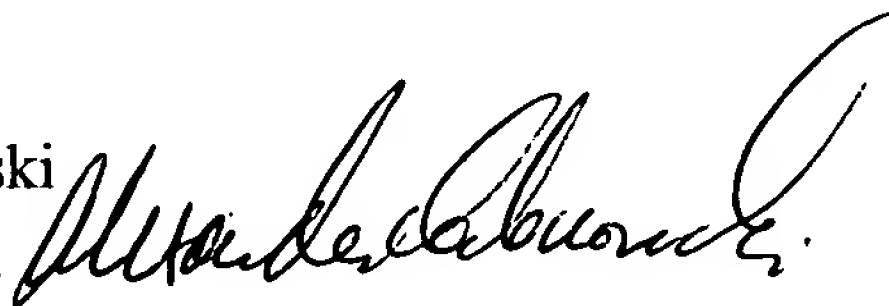
To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Alexander Kalinowski



Examiner notes that this application has been reopened as a result of a typographical error made by the Examiner in the grounds for rejection statement of the final Office Action mailed 9/20/05. Specifically the Office Action states that, "Claims 1-7, 9-11, and 13-26 are rejected under 35 USC 103(a) as being unpatentable over Cianciarulo et al in view of Kokubu." As noted above this was a typographical error as the cited claims should have been rejected over Cianciarulo et al in view of McCabe. (also see claims 8-12 rejected in view of Kokubu which should have been rejected in view of McCabe)

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Examiner notes that while it is clear that the intent of the Office Action was to use the McCabe reference (see Graham factual inquires on page 3 of the Final Office Action) the error still amounts to a new grounds of rejection and therefore must be reopened and clarified prior to advancing to the Board of Patent Appeals and Interferences.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cianciarulo et al. in view of McCabe.

Cianciarulo et al. teaches a system and method for insuring data over the Internet. In particular Cianciarulo et al. teaches receiving a request from a requestor to insure delivery of an electronic document (e.g. page 9; paragraph 0062; lines 7-12). Examiner notes that the data set represents Applicant's electronic document.

Cianciarulo et al. teaches responsive to the request, identifying a payment amount to insure delivery of an electronic document which represents an identified payment amount (e.g. page 8; paragraph 0055). Examiner notes that the appropriate fee of Cianciarulo et al. represents

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Applicant's payment amount. Further, applying an appropriate fee for selected coverage represents identifying a payment amount to insure delivery of an electronic document.

Cianciarulo et al. teaches sending an acknowledgement of the electronic document to the requestor, wherein the acknowledgement includes the identified payment amount and delivering the electronic document in response to receiving a reply to the acknowledgement from the requestor accepting the identified payment amount (e.g. page 10; paragraph 0064). Examiner notes that the teaching of a permission activated event represents Applicant's acknowledgement of the payment amount (appropriate fee).

Cianciarulo et al. does not teach that the payment amount to insure delivery is based on network characteristics , wherein the characteristics include transaction statistics.

McCabe teaches that a payment amount (mathematically fair price for insurance) is based on statistics associated with the type of insurance being purchased (page 4; paragraphs 0061-0062).

Examiner notes that McCabe states that applicants for insurance are put into classes according to their probability of loss and each class bears a mathematically fair share of the insurance pool's losses and expenses (based on that classes probability of loss). As such, the mathematically fair price for insurance is found by multiplying the probability of loss for a class times the dollar value exposed to loss, then adding a fair share of the insurer's expenses.

McCabe goes on to state that the risk classification technique described above is developed by observing defined events across large groups of people or entities. Examiner notes that observations defined across large groups of people or classes represents statistics. In other words, McCabe teaches that in order to determine a group's probability of loss, insurance companies rely on statistics associated with that group.

Therefore, McCabe teaches that the mathematically fair share for insurance is based on observations/statistics, since those observations/statistics define a group's probability for loss.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to base the appropriate price of Cianciarulo et al. on transaction statistics for each of the selected electronic transaction groups defined by Cianciarulo et al. as taught by McCabe. One of ordinary skill would have been motivated to combine these references as taught in order to produce a mathematically fair price for insurance.

Cianciarulo et al. teaches billing the requestor in response to receiving a reply to the acknowledgment accepting the identified amount (e.g. page 10; paragraph 0064).

Cianciarulo et al. teaches wherein the payment amount is received in a form of electronic cash, a credit card charge or a debit to an account (page 8; paragraph 55; lines 22-23). Examiner notes that the specific teaching referenced here on page 8 includes only the debiting of an account, but as the limitation is presented in the alternative, only one of the options is required to anticipate the claim.

Cianciarulo et al. teaches wherein identifying step includes taking into account a value of the electronic document in addition to network characteristics (pages 9-10; column 62; lines 38-48). Examiner notes that a coverage amount represents account value of the electronic document.

Cianciarulo et al. teaches wherein the identified value of the electronic document is received from the requestor (pages 9-10; column 62; lines 38-48). Examiner notes that the user of Cianciarulo et al. selects the amount of coverage thus defining the value of the electronic document.

Cianciarulo et al. teaches responsive to an inability to deliver the electronic document within a time guaranteed, sending a payment to requestor (page 6; column 0044; lines 3-9).

Cianciarulo et al. teaches receiving a request from a requestor to insure delivery of an electronic document (e.g. page 9; paragraph 0062; lines 7-12). Examiner notes that the data set represents Applicant's electronic document.

Cianciarulo et al. teaches receiving a delivery status of the electronic document (page 6; column 0041).

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Cianciarulo et al. teaches determining from the delivery status if the electronic document has been timely delivered and if the electronic document has not been timely delivered compensating the requestor (page 6; paragraph 0041 and page 6; paragraph 0044).

Cianciarulo et al. does not teach wherein the insurance of delivery is based on a number of times a party to whom the insurance is being provided has been paid insurance proceeds.

McCabe teaches using insurance claim statistics to determine an insurance premium (page 5; paragraph 0075).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the insurance of delivery of Cianciarulo et al. by using claims statistics to determine the premium as taught by McCabe. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to in order to help defray the costs associated with factors related to increased insurance claims (McCabe; page 5; paragraph 0075).

Response to Arguments

Applicant's arguments filed with the Appeal Brief on 1/10/06 have been fully considered but they are not persuasive.

Applicant asserts that Cianciarulo's "permissive activated event" does not teach the claimed limitation of "delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount." Examiner respectfully disagrees.

In rejecting this limitation Examiner referenced the entire paragraph 64 on page 10. Examiner notes that the paragraph teaches that the permission activated event authorizes a “selected coverage and a selected coverage amount.” The use of selected indicates that a system first presents the user with an amount based and be selected prior to the permission activated event. It is the Examiner’s position that this teaching represents Applicant’s claimed limitation.

Applicant further asserts that Examiner has not established a prime facie case of obviousness for fail to show the following claimed feature, “the network characteristics are maintained in a network database which is queried in response to identifying a delivery location for the electronic document such that the identified payment amount is based on the network characteristics of the network in which the electronic document is to be transmitted.” Examiner respectfully disagrees.

Examiner notes that while the cited paragraphs of McCabe does teach that “this does not necessarily work effectively with data and online presence,” the basis for this statement is because of the predictability of such ventures. Therefore, Examiner relies on McCabe to teach that such practices are effective for more predictable areas. Further, insuring electronic document deliver over a network is a much more predictable than an on-line store (or on-line presence) in that if an on-line store goes down sales are lost, whereas based on historical data a user could track network characteristics and make a predicable assessment of the success.

Based on these points, the Examiner maintains the position that modifying the traditional risk classification teachings of McCabe to establish an insurance fee in Cianciarulo does in fact present a proper prime facie case of obviousness.

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With respect points A.3-A.5, Applicant asserts that the prior art fails to teach an estimated amount of time. Examiner respectfully disagrees. Examiner notes that the prior art teaches the timely delivery of an electronic document. If amount of time were not a factor then there would be no way to prove that a document was not delivered. In other words, there must be an amount of time figured into the coverage fee.

In further support of this position Examiner enters as evidence an article by Steve Cardot (hereinafter Cardot) which describes the Portogo Insurance protection system. Examiner notes that Portogo is the assignee of the Cianciarulo et al reference and therefore this article is used to show inherent features of the Cianciarulo reference. Namely, Examiner points to page 2, 3rd paragraph, "process lets clients insure important Internet data and transmissions just as they would insure data sent by conventional mail or courier." Examiner notes that this clearly teaches the system includes an amount of time element to the coverage fees calculated in Cianciarulo.

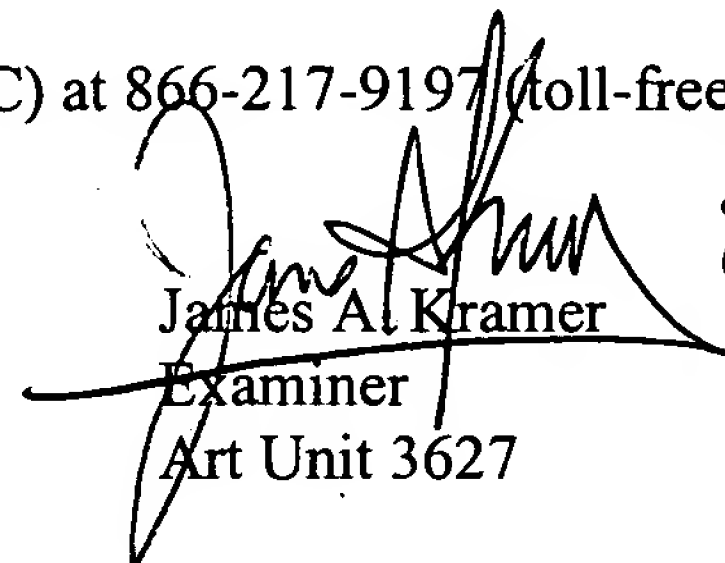
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James A. Kramer
Examiner
Art Unit 3627
3/27/06

jak